

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte REINHOLD SCHREIBER

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Appeal No. 1999-0410  
Application 29/063,883

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HEARD: FEBRUARY 7, 2000

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Before FRANKFORT, STAAB, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of the following design claim:

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The ornamental design for an UPHOLSTERY FILM PATTERN  
FOR VEHICLES as shown and described.

The invention is directed to the ornamental design of an upholstery film pattern, as seen in Figures 1 and 2 of the application.<sup>1</sup> As noted in appellant's specification, the characteristic feature of the design

resides in a plurality of embossments of  
which groupings thereof provide circular visual  
effects.

As explained on page 2 of the brief, the upholstery film at  
issues is intended to be for use on vehicle dashboards,  
interior trim and the like, so that

[als a design for dashboard material, the design is  
properly viewed at essentially an arm's length  
distance from the vehicle occupant, the distance at  
which occupants would normally view the design.  
When viewed at its usual and intended distance from  
the vehicle occupants, groupings of the embossments  
produce circular visual effects.

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<sup>1</sup> New photographs respectively designated as "Fig. 1" and "Fig. 2" were filed by appellant on December 5, 1997 (Paper No. 8). Those photographs have been entered by the examiner. See Paper No. 20, mailed September 22, 1999.

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The sole reference relied upon by the examiner is:

Satas

3,232,819

Feb. 1, 1966

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The appealed design claim stands rejected under 35 U.S.C. § 102(b) as being anticipated by Satas.

In addition, the design claim is also rejected under 35 U.S.C. § 103(a) as being unpatentable over Satas.

Reference is made to the examiner's answer (Paper No. 13, mailed September 1, 1998) for the examiner's full reasoning in support of the above-noted rejections. Attention is directed to appellant's brief (Paper No. 11, filed August 10, 1998) for an exposition of appellant's arguments thereagainst.

#### OPINION

Having carefully considered the anticipation and obviousness issues raised in this appeal in light of the applied Satas reference, the examiner's remarks in the answer and appellant's arguments in the brief, it is our conclusion that the examiner's rejections of the present design claim under 35 U.S.C. § 102(b) and § 103(a) cannot be sustained. Our reasons for these determinations follow.

Initially, we note that the proper test for determining novelty under 35 U.S.C. § 102 with respect to designs is the "ordinary observer" test (as distinguished from the "ordinary designer" test applicable in determining obviousness under 35 U.S.C. § 103). See In re Nalbandian, 661 F.2d 1214, 1217, 211 USPQ 782, 785 (CCPA 1981). With respect to the "ordinary observer" test for determining whether novelty is present under § 102 the court in In re Bartlett, 300 F.2d 942, 943-944, 133 USPQ 204, 205 (CCPA 1961) set forth (in quoting with approval from Shoemaker, Patents for Designs, page 76):

If the general or ensemble appearance-effect of a design is different from that of others in the eyes of ordinary observers, novelty of design is deemed to be present. The degree of difference required to establish novelty occurs when the average observer takes the new design for a different, and not a modified already-existing, design.

It therefore follows that, in order to establish lack of novelty (i.e., anticipation), the ordinary observer must take the general or ensemble appearance-effect of the design under consideration to be the same as that of an already-existing

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design (even though a degree of difference may actually be present). Stated another way, absolute identity of the reference and the claimed design is

not required to support a rejection for lack of novelty under 35 U.S.C. § 102, however, the reference must be virtually identical to the claimed design.

In the present case, when we view appellant's Figures 1 and 2 alongside Figure 1 of Satas, we are unable to agree with the examiner (answer, page 6) that the claimed design and that of the sheet material in Satas Figure 1 are "so strikingly similar that the claimed design would indeed be seen by an ordinary observer as a mere modification of the Satas design, and not as different." In our opinion, the visual impression created by the claimed design as seen in Figures 1 and 2 of the present application is significantly different from that created when viewing the embossed sheet material seen in Satas Figure 1. While the sheet material of Satas Figure 1 has an embossed surface that includes relatively large distinct generally circular areas that are apparently coalesced nodules and filamentary strands or fibers of the synthetic polymer used in making the sheet material, the claimed design has what appears to be an embossed surface that is made of very small embossments arranged in an entirely different manner than the

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large embossments seen in the material of Satas Figure 1. Like appellant (brief, page 8), we are of the view that because the embossment pattern as well as the sizes and shapes of the individual embossments constituting the pattern in the claimed design differ significantly from that seen in Figure 1 of the Satas reference, the claimed design cannot fairly be described as a mere modification of the surface design pattern seen in the sheet material of Satas.

Stated differently, and in accordance with the test for novelty in designs, we are of the opinion that the ordinary observer would view the general or ensemble appearance-effect of the claimed design to be different from that of the surface design seen on the sheet material depicted in Figure 1 of Satas.

This being the case, we will not sustain the examiner's rejection of appellant's design claim on appeal under 35 U.S.C. § 102(b) as being anticipated by Satas.

With regard to the examiner's rejection of the claimed design under 35 U.S.C. § 103(a) based on Satas, we do not



agree with the examiner (answer, page 5) that the claimed design "presents an appearance remarkably similar to that of the prior art." As we have already stated above, the overall appearance of the claimed design is, in our opinion, significantly different from that of the embossed sheet material seen in Satas Figure 1. Moreover, we must agree with appellant that it would not have been obvious to a designer of ordinary skill to modify the surface pattern as seen in Satas Figure 1 to emulate that of the claimed design. For that reason, the examiner's rejection of the claimed design under 35 U.S.C. § 103(a) based on Satas will also not be sustained.

In accordance with the foregoing, the decision of the examiner rejecting the claimed design under 35 U.S.C. § 102(b) and § 103 based on Satas is reversed.

In addition, we find it necessary to REMAND this application to the examiner for a consideration of whether or not a rejection of the design claim on appeal would be appropriate under either or both 35 U.S.C. § 112, first paragraph, as being nonenabling because the appearance and

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shape of all of the features and portions of the claimed design are not clearly disclosed in the photographs as originally filed or in the newly submitted photographs filed December 5, 1997, and/or 35 U.S.C. § 112, second paragraph, as being indefinite.

Both the photographs (Figures 1 and 2) and the narrative description in the specification are incorporated into the present design claim by appellant's use in the claim of the language "as shown and described." Thus, the groupings of the plurality of embossments which purportedly provide "circular visual effects" as described on page 2 of appellant's specification are a part of the claimed design. Our problem arises because we are at a loss to understand exactly what these "circular visual effects" are, since we do not see any such "circular visual effects" in the photographs (Figures 1 and 2) as originally filed or in the new photographs filed on December 5, 1997. Even the examiner has characterized the purported circular visual effects as being "so subtle as to be unnoticeable" (answer, page 7) and is on record as indicating that "[t]he only clear pattern discernible in the design is a wavy or linear configuration to the pattern." Thus, it appears to us that issues under 35 U.S.C. § 112, first and second paragraphs, have not yet been adequately resolved in this case.

A second point for consideration by the examiner is

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whether or not the new photographs filed December 5, 1997 have introduced new matter into the application. In this regard, it is readily apparent from a perusal of the originally filed photographs and those filed on December 5, 1997 that the photographs as originally filed create a somewhat different visual impression of the claimed design than that which is derived from looking at the newly filed photographs submitted on December 5, 1997. The lighter/brighter photographs filed on December 5, 1997 show what is apparently a more detailed depiction of the upholstery film pattern than that which is discernable from the darker photographs which were originally filed by appellant. Thus, there is an issue as to whether or not the change in the appearance of the claimed design occasioned by the newly filed

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lighter/brighter photographs is such a departure from the original disclosure that the newly filed photographs in fact introduce prohibited new matter.

REVERSED AND REMANDED

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	) APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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EVENSON, MCKEOWN, EDWARDS  
and LENAHAN  
1200 G STREET, N.W.  
STE. 700  
WASHINGTON, DC 20005